

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/492,697 01/27/00 DUJON

B 3495.0111-11

EXAMINER

HM12/0620  
Finnegan Henderson Farabow Garrett and D  
1300 I Street N W  
Washington DC 20005

KAUSHAL, S

ART UNIT

PAPER NUMBER

1633

DATE MAILED:

06/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/492,697	DUJON ET AL.
	Examiner	Art Unit
	Sumesh Kaushal	1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 30 March 2001.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 38-60 is/are pending in the application.

4a) Of the above claim(s) 38-44 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) \_\_\_\_\_ is/are rejected.

7) Claim(s) 45-60 is/are objected to.

8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

15) Notice of References Cited (PTO-892)

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .

18) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .

19) Notice of Informal Patent Application (PTO-152)

20) Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's response filed on 03/30/01 has been fully considered. Claims 23, 25-30 and 32-37 are canceled by the applicant (*claims 38-44 are not canceled*). Newly filed claims 45-60 are entered. Claims 38-60 are pending in this application.

Claims 38-44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 13.

The numbering of claims is not in accordance with 37 CFR 1.126, which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 43-58 been renumbered 45-60.

#### ***Election/Restrictions***

1. Applicant's election with traverse of Group I (claims 23-37 which have been replaced by new claims 45-60) in Paper No. 13 is acknowledged. The traversal is on the ground(s) that new claims 45-60 recites more than one species but do not exceed a reasonable number of species. The applicant argues that the requirement for restriction to a single species is improper and claims 45-60 be fully examined (response, page 4). The applicant further argues that refusal to examine full scope of claim 45 is improper and there is no allegation or explanation that the subject matter lacks unity of invention (response, page 5, para. 3). In addition, the applicant argues that the linking claims must be examined with the elected invention. Claim 45 is a genus claim linking the species of claims 44-47 (response, page 6, para. 4).

This is not found persuasive because genus claim 45 (*Group I intron-encoded endonucleases*) encompass various classes of endonucleases (*Class I, II, III, IV and V I-endonucleases*), wherein the Class II I-endonucleases further encompass *I-SceI, I-SceIV, I-CsmI and IPanI endonucleases*. As stated in the earlier office action (page 3), inventions are distinct if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In instant case the Class I, II, III, IV and V I-endonucleases are structurally and functionally distinct endonucleases. Furthermore I-SceI, I-SceIV, I-CsmI and IPanI endonucleases belonging to Class II endonucleases are also structurally and functionally distinct endonucleases. Therefore, the examination of elected invention is only limited to the recombinant mammalian chromosome, which encodes the I-SceI site. Furthermore, the instant application is not a National stage application of a PCT application (35 USC 371 case). Therefore, the lack of unity standards are not applicable the instant restriction requirement. Therefore, Group I (claims 45-60) is examined only to the extent that it encompasses the elected subject matter i.e. a recombinant mammalian chromosome encoding I-SceI endonuclease site.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 45-48, 50-51, 52-55 and 57-60 are objected to because of the following informalities: The instant claims encompass non-elected subject matter encompassing Group I intron encoded endonucleases sites, wherein the site is selected from Class I, II, III, IV and V I-endonucleases, wherein the Class II I-endonucleases encompass I-SceI, I-SceIV, I-CsmI and IPanI endonucleases. However, the elected species is only limited to a recombinant mammalian chromosome encoding an I-SceI endonuclease site. Appropriate correction is required.

3. Claims 45-48, 50-51, 52-55 and 57-60 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 13.

4. There is no allowable generic claim because the genus as claimed is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification fails to describe a recombinant mammalian chromosome and/or a recombinant cell comprising the chromosome, wherein the chromosome comprises an endonuclease site which encompasses all Group I intron-encoded endonucleases.

Similarly, the specification fails to describe a recombinant mammalian chromosome and/or a recombinant cell comprising the chromosome, wherein the chromosome comprises an endonuclease site which encompasses all Class I, II, III, IV and VI-endonucleases

Similarly, the specification fails to describe a recombinant mammalian chromosome and/or a recombinant cell comprising the chromosome, wherein the chromosome comprises an endonuclease site which encompasses by all Class II I-endonucleases

Similarly, the specification fails to describe a recombinant mammalian chromosome and/or a recombinant cell comprising the chromosome, wherein the chromosome comprises an endonuclease site which encompasses all I-SceI, I-SceIV, I-CsmI and IPanI endonucleases.

At best, the specification only disclosed a recombinant mammalian chromosome and/or a recombinant cell comprising the chromosome, wherein the chromosome comprises an I-SceI endonuclease site

#### ***Double Patenting***

Submission of Terminal Disclaimers is acknowledged in the applicant's response filed on 12/05/00.

*Conclusion*

No claims are allowed.

Claims 49 and 56 are objected to as being dependent upon a withdrawn base claim, but *would be allowable* if rewritten independently excluding all the non-elected limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumesh Kaushal Ph.D. whose telephone number is (703) 305-6838. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Deborah Clark can be reached on (703) 305-4051. The fax-phone number for the organization where this application or proceeding is assigned as (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent analyst Tracey Johnson, whose telephone number is (703) 308-0377. If the claims are amended canceled and/or added the applicants are required to follow Amendment Practice under 37 CFR § 1.121 (<http://www.uspto.gov>) and A CLEAN COPY OF ALL PENDING CLAIMS IS REQUESTED to facilitate further examination.

SUMESH KAUSHAL  
PATENT EXAMINER



SUMESH KAUSHAL  
PATENT EXAMINER